

REMARKS

Claims 1-55 are pending in the application. Claims 1, 11, 22, 32, 43, and 53 are independent. Claims 32-42 have been amended.

Claim Rejections – 35 USC § 101

The Patent Office rejected claims 32-42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 32 has been amended and it is believed that claims 32-42 contain statutory subject matter.

Claim Rejections – 35 USC § 102

The Patent Office rejected claims 1, 2, 7-13, 18-23, 28-33, 39-43, 49-53, and 55 under 35 U.S.C. § 102(e) as being anticipated by Bharati et al. (U.S. Patent Application No. 2003/0208593) (“Bharati”).

Applicant respectfully traverses the rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added.

Applicant respectfully submits claims 1, 2, 7-13, 18-23, 28-33, 39-43, 49-53, and 55 recite elements that have not been disclosed by Bharati. For example, claims 1, 11, 22, 32, 43, and 53 recite encoding a file marker with build of material information from a source file. The Patent Office cites to Bharati (page 2 paragraphs [0019] and [0020]) as disclosing the above referenced elements. However, Bharati does not disclose encoding a file marker with build of material information from a source file. Bharati does not mention a source file. Bharati collects an inventory of files on the computer and system properties of the computer. Bharati does not state how this information is collected. The

Patent Office stated that for information to be collected it must be stored in the computer and the location where the information is stored is the source file. However, Bharati does not collect information about a computer from a location on the computer. Bharati generates the information. The information in Bharati is not stored on the computer, it is generated from it. Generating an inventory of files on the computer and system properties of a computer is not equivalent to obtaining build of material information from a source file. Thus, the source of the information in Bharati is not equivalent to the source file of the present invention. Consequently, elements of claims 1, 11, 22, 32, 43, and 53 have not been taught, disclosed or suggested by Bharati. Under *Lindemann*, a *prima facie* case of anticipation has not been established for claims 1, 11, 22, 32, 43, and 53, thus claims 1, 11, 22, 32, 43, and 53 are believed allowable. Claims 2, 7-10, 12-13, 18-21, 23, 28-31, 33, 39-42, 49-52, and 55 are believed allowable due to their dependence upon claims 1, 11, 22, 32, 43 and 53, respectively.

Claim Rejections – 35 USC § 103

The Patent Office rejected claims 3, 4, 14, 15, 24, 25, 35, 36, 45, 46, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Bharati in view of Fitting (U.S. Patent No. 5,857,192) (“Fitting”).

Applicant respectfully traverses. Applicant respectfully submits claims 3, 4, 14, 15, 24, 25, 35, 36, 45, 46, and 54 include novel and nonobvious elements. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 3 and 4 depend from allowable claim 1 and are believed allowable due to their dependence on an allowable base claim. Claims 14 and 15 depend from allowable claim 11 and are believed allowable due to their dependence on an allowable base claim. Claims 24 and 25 depend from allowable claim 22 and are believed allowable due to their dependence on an allowable base claim. Claims 35 and 36 depend from allowable claim 32 and are believed allowable due to their dependence on an allowable base claim. Claims 45 and 46 depend from allowable claim 43 and are believed allowable due to their dependence on an allowable base claim. Claim 54 depends from allowable claim 53 and is believed allowable due to its dependence on an allowable base claim.

The Patent Office rejected claims 5, 16, 26, 37, and 47 under 35 U.S.C. § 103(a) as being unpatentable over Bharati and Fitting in further view of Richard (U.S. Patent No. 6,920,492) ("Richard"). Applicant respectfully traverses. Claim 5 depends from allowable claim 1 and is believed allowable due to its dependence on an allowable base claim. Claim 16 depends from allowable claim 11 and is believed allowable due to its dependence on an allowable base claim. Claim 26 depends from allowable claim 22 and is believed allowable due to its dependence on an allowable base claim. Claim 37 depends from allowable claim 32 and is believed allowable due to its dependence on an allowable base claim. Claim 47 depends from allowable claim 43 and is believed allowable due to its dependence on an allowable base claim.

The Patent Office rejected claims 6, 17, 27, 38, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Bharati in view of Christofferson et al. (U.S. Patent No. 6,915,302) ("Christofferson"). Applicant respectfully traverses. Claim 34 depends from allowable claim 32 and is believed allowable due to its dependence on an allowable base claim. Claim 6 depends from allowable claim 1 and is believed allowable due to its dependence on an allowable base claim. Claim 17 depends from allowable claim 11 and is believed allowable due to its dependence on an allowable base claim. Claim 27 depends from allowable claim 22 and is believed allowable due to its dependence on an allowable base claim. Claim 38 depends from allowable claim 32 and is believed allowable due to its dependence on an allowable base claim. Claim 48 depends from

allowable claim 43 and is believed allowable due to its dependence on an allowable base claim.

The Patent Office rejected claims 34 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Bharati in view of Richard. Applicant respectfully traverses. Claim 34 depends from allowable claim 32 and is believed allowable due to its dependence on an allowable base claim. Claim 44 depends from allowable claim 43 and is believed allowable due to its dependence on an allowable base claim.

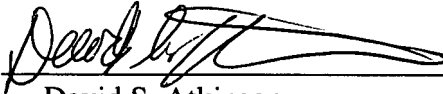
CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,

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